

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 3, and 5-9 are pending in the application, with claim 1 being the sole independent claim. Claims 1, 3, 6, and 8 are sought to be amended for clarity. Claims 2 and 4 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Applicant reserves the right to prosecute similar or broader claims, with respect to any amended claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Statement of Substance of Examiner Interview

The Examiner, Minnah Seoh, is thanked for her time during an Examiner Interview held December 16, 2010. Applicant's representative, Jason D. Eisenberg, discussed several distinguishing claim features regarding the applied reference. The Examiner proposed some claim language and presented additional potential references for Applicant's consideration. No agreement was reached.

Objections to the Drawings

The drawings were objected to for being illegible in places and including Korean language text. Applicant requests the objection be held in abeyance as Applicant is using a draftsman to prepare formal drawings that Applicant believes should overcome all objections.

Rejection under 35 U.S.C. § 102

Claims 1-8¹ are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,047,259 to Campbell et al. (“Campbell”). Applicant respectfully traverses the rejection and the Response to Arguments at pages 6-9 of the Office Action.

Without acquiescing to the propriety of the rejection, claim 1 has been amended to clarify the distinguishing features. For example, claim 1 recites a method comprising:

providing, by the service-providing system, a menu through the web screens, the menu allowing the users to insert an image into the medical record forms,

wherein the image is either a photographed image obtained by photographing a wound portion of a patient or an image template used for illustration, and is stored together with the medical information on patients input into the medical record forms,

wherein the image template used for illustration is uploaded to or modified or deleted in the service-providing system by an image template management menu provided on the web screens, and the uploaded or modified image template is stored in a folder designated by the user or automatically in a folder designated according to the user information and is stored together with the medical information for treating patients through the menu enabling the insertion of the image.

The Office Action, at pages 3-5, relies on Campbell for the teachings of previously pending claims 1, 2, and 4, and states that Campbell teaches that the image template used for illustration is uploaded to or modified or deleted in the service-providing system by an image template management menu provided on the web screens, and the uploaded or modified image template is stored in a folder designated by the user or automatically in a folder designated according to the user information and is stored together with the medical information on patients through the menu enabling the insertion of the image. In particular, the Office Action relies on col. 15, lines 56-57 and col. 16, lines 5-6 of Campbell.

Further, the Office Action, with respect to previously pending claim 4 at page 5 of the Office Action, improperly states that the choice of where to store the image

¹ Applicant notes claims 1-9 were pending, and claims 1-9 are rejected in the body of the rejection, although the Examiner states claims 1-8 in Section 8 of the Office Action. Therefore, Applicant will assume the Examiner meant to state claims 1-9 in Section 8, and will respond accordingly.

template would have been obvious to one of ordinary skill in the art at the time of the invention, and in order to simplify the filing system, it would have been obvious to create a folder with all of a patient's files and continue storing all information on the patient in that folder. Applicant respectfully reminds the Examiner that the Examiner has asserted Campbell *anticipates* previously pending claim 4, but provided an *obviousness* rationale for rejecting previously pending claim 4. Thus, Applicant requests the Examiner reconsider and withdraw the improper anticipatory rejection regarding the subject matter of previously pending claim 4, now recited in pending claim 1.

Applicant respectfully asserts that Campbell neither discloses, teaches nor suggests at least the above-noted distinguishing features of independent claim 1, for at least the following reasons.

Campbell discloses “a screen 700 used to prompt the user for *graphical input of medical observation*. The screen displays a graphical representation of the pet 702, 704 and *enables the user to mark the location of lesions on the skin graphically*. ...Each time the user clicks on the graphical representation, the client software records medical observations as observation records in a database file.” (Campbell, col. 15, line 55- col. 16, line 13)(emphasis added).

That is, in Campbell, a graphical representation of the pet 702, 704 is an image for enabling a user to mark a wound portion graphically, and is not the claimed image *obtained by photographing a wound portion or an image template used for illustration and comparison*. Thus, Campbell has no disclosure, teaching, or suggestion that “the image is either *a photographed image obtained by photographing a wound portion of a patient or an image template used for illustration*,” as recited in claim 1.

Further, since Campbell does not disclose, teach or suggest that the image is the claimed image template used for illustration, Campbell also does not disclose, teach, or suggest “*the image template used for illustration is uploaded to or modified or deleted in the service-providing system*” and “*the uploaded or modified image template is stored in a folder designated by the user or automatically in a folder designated according to the user information*,” recited in claim 1.

With regards to the Examiner's statements on page 4 of the Office Action that claim 1 recites "intended use," and thus has no patentable weight, the Examiner has ignored the 119 year old Doctrine of Slight Change, which allows for patentability where an old product or process has a new use and the old product or process must be altered, however slightly, to fit the new use discovered by an inventor. See, e.g., *Toplif v. Toplif*, 145 U.S. 156 (1892), *Potts v. Creager*, 155 U.S. 597 (1895), *Hobbs v. Beach*, 180 U.S. 383 (1900), *Traitel Marble Co. v. U.T. Hungerford Bass & Copper Co.*, 18 F.2d 311 (2nd Cir. 1927); and *H.C. White v. Morton E. Converse & Son Co.*, 20 F.2d 311 (2nd Cir. 1927). Also, as the M.P.E.P. at § 2111.03 notes, the recitation "must be evaluated to determine whether the ... intended use results in a ... **manipulative difference** ... between the claimed invention and the prior art. If so, the recitation serves to limit the claim." *M.P.E.P. § 2111.03 (emphasis added)*. Clearly, claim 1 recites features that are not taught in Campbell without Campbell's system being altered to meet the claims.

Finally, with respect to the Examiner's arguments on pages 6-9 of the Office Action, all features recited in a claim carry patentable weight, including the Examiner alleged functional features. See, e.g., *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796 (Fed. Cir. 1990) *cert denied sub nom Perry v Amerace Corp.* 502 U.S. 808 (1991) (stating functional language, in appropriate cases, cannot be disregarded); *ACCO Brands, Inc. v Micro Security Devices, Inc.*, 346 F.3d 1075 (Fed. Cir. 2003) (stating the functional language in a claim can be limiting when viewed in light of the specification); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) ("The function language is, of course, an additional limitation in the claim"); *Medrad, Inc. v MRI Devices Corp.* 401 F.3d 1313 (Fed. Cir. 2005) ("It is therefore entirely proper to consider the functions of an invention in seeking to determine the meaning of a particular claim language."); *In re Mills*, 916 F.2d 680, 682-83 (Fed. Cir. 1990) (stating the PTO erred even when differences "lie solely in the functional language of the claims"); *In re Stencel*, 828 F.2d 751, 755 (Fed. Cir. 1987) (stating claims reciting structure and purpose [functionality] are patentable when there is no suggestion in the prior art of an apparatus having the claimed structure and purpose).

Accordingly, Applicant respectfully asserts that the rejection of claim 1 under 35

U.S.C. § 102(b) should be withdrawn because Campbell does not anticipate (nor render obvious) independent claim 1. Furthermore, Applicant respectfully asserts that the rejection of dependent claims 3 and 5-9 under 35 U.S.C. §102(b) should be withdrawn at least because of their dependency from claim 1 and the reasons set forth above, as well as for their additional distinguishing features.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jason D. Eisenberg #43447/

Jason D. Eisenberg
Attorney for Applicant
Registration No. 43,447

Date: January 20, 2011

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600